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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,180	04/22/2004	Satoru Wakao	1232-5393	7729

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EXAMINER	
PICH, PONNOREAY	
ART UNIT	PAPER NUMBER
2435	

NOTIFICATION DATE	DELIVERY MODE
12/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/830,180	WAKAO ET AL.	
	Examiner	Art Unit	
	PONNOREAY PICH	2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5,7-11,13 and 15-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5,7-11,13 and 15-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-3, 5, 7-11, 13, and 15-17 are pending. Applicant's amendments and arguments directed at the amended claims were fully considered, but are moot in view of new rejections made below in response to the amendments.

Information Disclosure Statement

The IDS submitted on 9/30/08 was considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 1 has been amended to recite that the image processing apparatus comprises "an alteration unit" and "a control unit". The specification fails to define what is considered a "unit" and applicant's remarks filed with the latest amendments failed to shed any light on the matter. As such, the metes and bounds of the claims cannot be determined.
2. Claims 17 has been amended to recite "A computer-readable medium". It is noted that applicant's specification defines a "transmission medium" and a "recording medium" (see page 45 of the specification), but not a "computer-readable medium". Applicant's remarks filed with the latest amendments also failed to shed any light on what is meant to be encompassed by the term

"computer-readable medium", thus the metes and bounds of the claim cannot be determined.

3. Claims not specifically addressed are rejected due to dependency.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 5, 7-8, and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1, as discussed above, applicant's specification and remarks failed to shed any light as to what is meant to be encompassed by "an alternation unit" and "a control unit", which the claimed imaging processing apparatus comprises. Because it is unclear what the metes and bounds of each of these claimed units are, in applying the broadest, reasonable interpretation to the claim, it is assumed that an alternation unit and a control unit as recited in claim 1 could be software units per se. As such, claim 1 is rejected as being non-statutory since software does not fall within any of the four statutory categories of invention. Claims 2-3, 5, and 7-8 are also not statutory because there is nothing recited in any of these claims which would require one to interpret that anything more than software per se is being claimed.

Claim 17 is rejected as being non-statutory because as discussed above, applicant failed to provide any sort of guidance as to what is meant to be encompassed by the term "computer-readable medium". In applying the broadest, reasonable

interpretation to the term, it is assumed that "computer-readable medium" could also encompass a signal, thus is not statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 9, 13, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ibaraki et al (US 6,434,538).

Claims 1, 9, and 17:

As per claim 1, Ibaraki discloses:

1. An alternation unit that alters a first image file, stored in a removable storage medium in order to generate a second image file (col 7, lines 7-20 and col 12, lines 44-52).
2. A control unit that controls to store the second image file in the storage medium without deleting the first image file from the storage medium, if the first image file includes authentication data (i.e. digital signature f(M)) that is used to authenticate whether the first image file has been altered (col 3, lines 9-55; col 4, lines 10-20; col 7, lines 7-20; and col 12, lines 44-52).

Claim 9 is directed towards a method performed using the apparatus of claim 1 and is rejected for much the same reasons as claim 1. Claim 17 is directed towards a computer-readable medium storing a computer program for realizing the method according to claim 9, which is performed using the apparatus of claim 1, thus is rejected for much the same reasons as claim 1. One skilled should appreciate that Ibaraki's invention utilizes a computer system, thus it is inherent that it have a computer-readable medium storing a computer program to implement Ibaraki's invention.

Claims 5 and 13:

Ibaraki implicitly disclose wherein the alternation unit generates the second image file that does not include the authentication data, if the first image file includes the authentication data (col 6, lines 37-42 and col 7, lines 8-20). *An image could be a one-time copy image, which means that after it has been copied once, no more copy of the image is allowed to be made. This means that the second image does not include a copy of the digital signature f(M), which would allow another image to be made from the second image. If this was not the case, then the image would not be "one-time copy".*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-3, 7, 10-11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ibaraki et al (US 6,434,538).

Claims 2 and 10:

Ibaraki does not explicitly disclose wherein the second image file is stored in the same folder as a folder in which the first image file is stored. However, official notice is taken that storing a copy of a data or image file in the same folder as the original was well known in the art at the time applicant's invention was made. It would have been obvious to one skilled in the art to modify Ibaraki's invention such that the second image file is stored in the same folder as a folder in which the first image file is stored. One skilled would have been motivated to do so because where to store a copy of a data or image file is a matter of user preferences.

Claims 3 and 11:

Ibaraki does not explicitly disclose wherein the second image file is stored in a folder different from a folder in which the first image file is stored. However, official notice is taken that storing a copy of a data or image file in a different folder than the original was well known in the art. It would have been obvious to one skilled in the art to modify Ibaraki's invention such that the second image file is stored in a folder different from a folder in which the first image file is stored. One skilled would have been motivated to do so because where to store a copy of a data or image file is a matter of user preferences.

Claims 7 and 15:

Ibaraki does not explicitly disclose wherein a part of a file name of the second image file is the same as a part of a file name of the first image file. However, official notice is taken that this limitation was well known in the art at the time applicant's invention was made. In Windows systems as early as Windows 95, for example, if one made a copy of a file in the same folder as the original file, Windows by default names the copy "Copy of" plus the name of the original file. At the time applicant's invention was made, it would have been obvious to one skilled in the art to modify Ibaraki's invention according to the limitations recited in claims 7 and 15. It would have been obvious to one skilled in the art to do so because it would be nothing more than applying a known technique to a known device ready for improvement to yield predictable results.

Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ibaraki et al (US 6,434,538) in view of Kondoh et al (US 6,968,058).

Claims 8 and 16:

Ibaraki does not explicitly disclose wherein the image processing apparatus is an image sensing apparatus. However, Kondoh discloses the limitation (Fig 1, camera 100). At the time applicant's invention was made, it would have been obvious to one skilled in the art to modify Ibaraki's invention such that the image processing apparatus was an image sensing apparatus/camera as per Kondoh's teachings. It would have been obvious to one skilled in the art to modify Ibaraki's invention to be a camera as per

Kondoh's teachings because simple substitution of one known element (i.e. type of image processing apparatus) for another to yield predictable results is obvious.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PONNOREAY PICH whose telephone number is (571)272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ponnoreay Pich/
Examiner, Art Unit 2435
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